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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,993	10/15/2001	Sumio Iwase	09812.0443	4325
22852	7590	04/13/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			04/13/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/869,993

Applicant(s)

IWASE, SUMIO

Examiner

SARA CHANDLER

Art Unit

3693

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to an auction system for carrying out an auction in a network to which a plurality of nodes are connected..
- II. Claims 7-10, drawn to an auction processing method for hosting an auction in a network to which a plurality of nodes are connected.
- III. Claims 11-18, drawn to an auction processing apparatus connected to a network to which a plurality of nodes are connected, receiving a bid transmitted from any node via said network, and hosting the auction of a desired product.
- IV. Claims 19, drawn to an auction processing method for receiving a bid transmitted from any node via a network and hosting an auction of a desired product in an apparatus connected to a network to which a plurality of nodes are connected.
- V. Claims 20-21, drawn to an auction processing apparatus for submitting a product for auction to a system disclosing information describing products and hosting auctions with respect to the products on a network to which a plurality of nodes are connected.

- VI. Claims 22-23, drawn to 22. An auction processing method for submitting a product for auction to a system disclosing information describing products and hosting auctions for related products on a network to which a plurality of nodes are connected.
- VII. Claims 24-34, drawn to an auction system for hosting auctions in a network to which a plurality of nodes are connected..
- VIII. Claims 35-41, drawn to an auction processing method for hosting an auction in a network to which a plurality of nodes are connected.
- IX. Claims 42-50, drawn to an auction processing apparatus having a shipping information requesting means connected to a network to which a plurality of nodes are connected.
- X. Claims 51 and 52, drawn to an auction processing apparatus/method connected to a network to which a plurality of nodes are connected and hosting an auction of any product.
- XI. Claims 53-57, drawn to an information processing system.
- XII. Claims 58-62, drawn to a second step of raising a suit with respect to said service by transmitting petition information to a trial processing side

The following inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable.

Inventions I and II; I and III; I and IV; I and V; I and VI; I and VII; I and VIII; I and IX; I and X; I and XI; I and XII: In the instant case, subcombination I has separate utility such as a submitting node for transmitting information describing a product and information including sale conditions to a sponsor node for any product and submitting the product in the auction. See MPEP § 806.05(d).

Inventions II and III; II and IV; II and V; II and VI; II and VII; II and VIII; II and IX; II and X; II and XI; II and XII: In the instant case, subcombination II has separate utility such as a submitting node transmits information describing a product, information of sale conditions, and information indicating whether or not the product is to be submitted for auction again if a transaction fails to be established to an auction sponsor node for the product to be submitted, the sponsor node changes part or all of the content of said disclosure relating to the product and said sale conditions for a product failing in establishment of a transaction and for which an instruction for submitting the same for auction again was given and includes the same as a product for auction again. See MPEP § 806.05(d).

Inventions III and IV; III and V; III and VI; III and VII; III and VIII; III and IX; III and X; III and XI; III and XII: In the instant case, subcombination III has separate utility such as an auction receiving means for receiving an application for auction for any product

including information describing the product and information of sale conditions of the product and including the product as a product for auction, a successful bid determining means for determining a purchaser of the product from applications for purchase received within a predetermined period for said product for auction and having purchase conditions of the application matching with said sale conditions of the product, and a re-auction means for changing part or all of said sale conditions and said information describing the product to be disclosed according to a predetermined process for a product for which a purchaser could not be determined and including the product as a product for auction again. See MPEP § 806.05(d).

Inventions IV and V; IV and VI; IV and VII; IV and VIII; IV and IX; IV and X; IV and XI; IV and XII: In the instant case, subcombination IV has separate utility such as receiving an application for auction for any product including information describing the product and information of sale conditions of the product and including the product as a product for auction, determining a purchaser of the product from applications for purchase received within a predetermined period for said product for auction and having purchase conditions of the applications matching with said sale conditions of the product, changing part or all of said sale conditions and said information describing the product to be disclosed according to a predetermined process for a product for which said purchaser could not be determined and including the product as a product for auction again. See MPEP § 806.05(d).

Inventions V and VI; V and VII; V and VIII; V and IX; V and X; V and XI; V and XII: In the instant case, subcombination V has separate utility such as an auction

applying means for transmitting information describing a related product including information describing said product to be disclosed, said sale conditions of the product, and said instruction relating to re-auction for a product for submission to said node receiving auctions. See MPEP § 806.05(d).

Inventions VI and VII; VI and VIII; VI and IX; VI and X; VI and XI; VI and XII: In the instant case, subcombination VI has separate utility such as generating an application for auction for any product including information describing a product, sale conditions of the product, and an instruction for automatically changing part or all of said information describing the product to be disclosed and said sale conditions and instructing whether or not the product is to be submitted for auction again when a transaction was not established in the auction and transmitting said generated application for auction to said node receiving auctions on said network. See MPEP § 806.05(d).

Inventions VII and VIII; VII and IX; VII and X; VII and XI; VII and XII: In the instant case, subcombination VII has separate utility such as an auction sponsoring means comprised on any node of said network, disclosing the submitted product by a format enabling viewing from any node on said network, receiving a bid from a bidding means on any node, determining the successful bidder for selling the product to from the bidding means placing bids, and transmitting information relating to shipping of said product to said submitting means and said successful bidder. See MPEP § 806.05(d).

Inventions VIII and IX; VIII and X; VIII and XI; VIII and XII: In the instant case, subcombination VIII has separate utility such as determining a successful bidder for

selling the product to from received bids, and transmitting information relating to said successful bid and information relating to shipping of the product to a submitter of the product and successful bidder. See MPEP § 806.05(d).

Inventions IX and X; IX and XI; IX and XII: In the instant case, subcombination IX has separate utility such as transmitting information of the result of a successful bid of an auction to a shipping arranging means on any node on the network and requesting information relating to shipping of the successfully bid product from a submitter to a successful bidder. See MPEP § 806.05(d).

Inventions X and XI; X and XII : In the instant case, subcombination X has separate utility such as acquiring information relating to the shipping of the successfully bid product from the submitter to the successful bidder based on the result of said successful bid, and transmitting the information of the result of said successful bid and said information relating to shipping to said submitter and successful bidder.. See MPEP § 806.05(d).

Inventions XI and XII: In the instant case, subcombination XI has separate utility such as receiving means connected to said network and receiving petition information of a suit with respect to said service transmitted via said network. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a

continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of an invention to be examined even though the requirement

may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has not contacted the applicant for election over telephone due to the complex nature of the election/restriction requirement (see MPEP §812.01 (R-3)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC
/JAGDISH N PATEL/
for JAGDISH N PATEL, Examiner of Art Unit 3693